

REMARKS

Claims 1-72 are pending.

In the Office action, the claims were rejected as follows:

- Claims 1-48 and 71-72 were rejected under 35 U.S.C. §103 as unapentable over U.S. Patent No. 6,367,696 (Inamitsu et al.).
- Claims 49-70 were rejected under 35 U.S.C. §103 as unapentable over the combination of the Inamitsu et al. patent and U.S. Patent No. 6,161,059 (Tedesco et al.).

As discussed below, applicant respectfully disagrees.

Claims 1-48 and 71-72 are patentable

The subject matter of the pending claims relates to a discount means (*e.g.*, a token or coupon) that is *separate from* the cash or card (*e.g.*, a credit card or debit card) that a customer or other person may use in connection with the purchase of products or services from an automatic transaction machine.

Using a discount means that is separate from the cash or card that the customer otherwise uses for a vend transaction may provide greater flexibility to the vendors of the products and services offered by the automatic transaction machines. For example, providing a separate discount means may serve as an enticement for a customer to make further vending purchases. Many vending machine owners have several vending machines next to one another that contain different types of products, such as soft drinks in one and snacks in another. If a customer purchases a soft drink, then a snack coupon, for example, may be dispensed to encourage the customer to buy a snack from another vending machine that accepts coupons.

The Inamitsu et al. patent discloses a technique for providing a discount to a purchaser of a product from an automatic vending device. That patent discloses the use of an IC card that stores electronic money ("e-money") data. When a customer wishes to make a transaction, the customer inserts the IC card in to a card reader associated with the vending device and makes a

selection by pushing a button on the vending machine. A microcomputer associated with the vending machine transfers the e-money equivalent of the price for the selected product(s) from the purchaser's IC card to the seller's IC card (col. 5, lines 12-17). In some situations, the system may provide the customer with a discounted price.

In contrast to the pending claims, the Inamitsu et al. patent envisions vending machine transactions taking place through the use of a single IC card provided by the user. There is no suggestion of using a discount means that is provided by the user and that is separate from the cash or card that the customer uses to facilitate the transaction. To the contrary, according to the Inamitsu et al. patent, after the user has provided his IC card to the system, if the proper conditions are met, then the system automatically provides the discount. There is no need for the customer to use any separate discount means. Nor does the system need to validate a separate discount means, as recited in pending claims 1 and 25.

At least for the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of the rejections of independent claims 1 and 25.

Dependent claims 2-24, 26-48 and 71-72 should be allowed at least for the reasons discussed above with respect to claims 1 and 25. Furthermore, the dependent claims include additional features that make those claims independently patentable. Some of the features implicitly assume that the discount means is separate from the cash or card that also is validated.

For example, claims 2 and 26 recite processing the discount value as a "phantom coin signal." The use of a phantom coin signal is discussed in greater detail below in connection with independent claim 63. There is simply no suggestion of such a signal in the cited references.

Similarly, claims 4 and 27 recite "returning a validated card but not the discount means. Even if, as apparently implied by the Office action, the IC card 8 disclosed in the Inamitsu et al. patent were considered to serve as both a card and a discount means, then clearly it is not possible in the system of the Inamitsu et al. patent to return a validated card, but not the discount means.

Claims 11 and 34 recite "returning change" for the amount specified. There is no suggestion in the Inamitsu et al. patent of returning any amount of change.

Claims 12, 13, 35, 36 relate to the possible use of multiple discount means. There is no suggestion of such a feature in the cited references.

Similarly, there is no disclosure or suggestion of waiting for additional deposit of cash, card or discount means as recited in claim 17-18 and 40-41.

The Office action (at page 5) acknowledges that the Inamitsu et al. patent "lacks an explicit recitation of some of the elements and limitations of claims 26-48. Yet, the Office action then states:

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 26-48 were well known and expected in the art by one of ordinary skill at the time of the invention, . . ."

There is absolutely no basis for such a conclusory statement.

Furthermore, the Court of Appeals for the Federal Circuit has stated that deficiencies of the cited references cannot be remedied by general conclusions about what is "basic knowledge or common sense." *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Instead, as pointed out in applicant's reply to the previous Office action, the suggestion to modify the prior art to obtain the claimed subject matter must be "clear and particular." *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002).

For the foregoing additional reasons, the rejections of claims 26-48 should be withdrawn.

Claims 63-70 are patentable

Independent claim 63 recites a discount device that makes use of a "phantom coin signal." As explained in the specification:

When coins or bills – defined as cash – are inserted through the apertures provided on the automatic vending machine, coin signals can be generated by the discount device to count the amount deposited. In an implementation, a "phantom" coin signal can be generated for the count for the token or coupon. The term "phantom" is used in connection with signals of the discount means as opposed to those of the deposited cash.

(Page 2, lines 10-16) As further explained in connection with a particular implementation:

In this implementation, the value of tokens or coupons are translated into coin signals which may be transmitted to the vending controller 130. The vending controller then only sees cash (coin) signals and does not have to be capable of calculating any discounts. Thus, the appropriate software to generate the phantom coin signals could be resident in only the coin validator (for tokens) or the bill validator (for coupons) or in another discount device. Consequently, an existing automatic translation machine can be easily upgraded without having to change the vending controller software.

(Page 23, lines 8-17)

The cited references do not disclose or suggest a phantom coin signal, as recited in claim 63. Instead, according to the IC card reader system disclosed in the Inamitsu et al. patent, the microcomputer 2 simply transfers the e-money equivalent of the appropriate price information (either the ordinary price or a discount price) from the purchaser's IC card to the seller's IC card (col. 5, lines 5-17). All the ordinary prices and the discount prices are stored in a memory unit 3. *Id.* Therefore, according to the Inamitsu et al. patent, the amount by which the price is discounted is not processed at all, and certainly is not processed as a phantom coin signal.

Therefore, claim 63, as well as dependent claims 64-69, should be allowed.

The Office action (at page 8) also makes an "Official Notice" argument regarding the additional features recited in claims 64-70. The remarks above regarding "Official Notice" are applicable here as well.

Claims 49-62 are patentable

Independent claim 49 recites a discount device that includes validating means for validating a discount means and a coin mechanism connected to the validating means, for "converting the discount value into a signal." For reasons similar to those discussed above in connection with the phantom coin signal recited in claim 63, applicants submit that there is no disclosure or suggestion of such a signal in the cited references.

Although the Office action states that it would have been obvious to incorporate the coin acceptor of the Tedesco et al. patent into the card reader system of the Inamitsu et al. patent so as to obtain the claimed subject matter, that is incorrect for several reasons.

First, the Inamitsu et al. patent envisions that the IC card reader will replace the note-and-coin identification unit in the vending machine (col. 4, lines 38-44). In other words, the Inamitsu et al. patent suggests that if the IC card reader is used, there is no need for the coin or bill validators. A customer simply will use an IC card that stores e-money to complete a vending machine transaction.

Second, even if there were some reason to incorporate a coin acceptor into the card reader system of the Inamitsu et al. patent, there would have been no suggestion of whether and how the coin acceptor should be connected to the IC card reader. In particular, there would have been no suggestion of a coin mechanism connected to the validating means, for converting the discount value that is associated with the discount means into a signal, as recited in claim 49. There is simply no suggestion in the cited references that a discount value obtained by the Inamitsu et al. patent's IC card reader should be, or even could be, converted into a signal by a coin acceptor connected to the IC card reader.

At least for those additional reasons, claim 49 also should be allowed.

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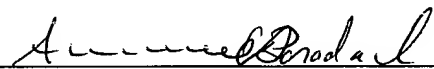
Some of dependent claims 50-62 recite features that have been addressed above in connection with claims 1-48. The same additional reasons for patentability are applicable with respect to the respective claims 50-62.

The Office action (at page 6) also makes an "Official Notice" argument regarding the additional features recited in claims 50-62. The remarks above regarding the "Official Notice" are applicable here as well.

Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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